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IN THE

In the Supreme Court of the United States

STAR ATHLETICA, L.L.C.,
Petitioner,

v.

VARSITY BRANDS, INC., ET AL.,

Respondents.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

BRIEF OF *AMICUS CURIAE* AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY

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STATEMENT OF INTEREST

The American Intellectual Property Law Association ("AIPLA") is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private and corporate practice, in government service, and in the academic community. AIPLA's members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.[1]

AIPLA has no stake in the parties to this litigation or in the result of this case, other than its inter-

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[1] In accordance with Supreme Court Rule 37.6, AIPLA states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than AIPLA and its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to the litigation in this matter, (ii) no representative of any party to this litigation participated in the authorship of this brief, and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

est in the correct and consistent interpretation of the laws affecting intellectual property.[2]

SUMMARY OF ARGUMENT

Courts and commentators have developed a number of tests to determine whether the copyrightable design elements of a work[3] are "separable" from non-protectable "utilitarian aspects" that also may be present in the work. Petitioner asks this Court to select one. However, these tests are not mutually exclusive: each of them addresses the same ultimate separability issue. Which test will be most useful often will depend on the work involved in the particular case.

However, apart from identifying "the test" for this determination, there is the risk that the subtlety and nuance of these separability tests will obscure their ultimate purpose and the statutory framework into which they must fit. Under that framework, the first inquiry must always be whether the work at issue contains design elements that are protectable under the Copyright Act—and if so, what those elements are. The second inquiry is whether the work also includes useful (and thus, unprotectable) features. That is where the various separability tests come into play.

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[2] AIPLA has the consent of the parties to file this amicus brief, pursuant to Supreme Court Rule 37.3(a), based on letters filed with the Court by Petitioner and Respondent granting blanket consent to the filing of amicus briefs.

[3] In this brief, "work" refers to an item that may be a "creative work of authorship" under the Copyright Act, depending on whether it meets various statutory requirements.

This order of inquiry ensures that the focus stays where the Copyright Act places it: on the copyrightable design elements themselves, and whether they are inseparable from a useful object.

The Sixth Circuit's analysis in this case, however, illustrates how that inquiry has sometimes become inverted. The court below put the primary focus on identifying the useful aspects of cheerleading uniforms, and only then asked whether the specific design elements in this case are separable from those uses, and potentially protected under U.S. copyright law. That approach may yield the right outcome in many cases, but sometimes it will also lead to error because it puts the cart before the horse.

Courts should not identify an work's useful aspects in the abstract, as the Sixth Circuit apparently did here. Instead they should first consider whether the work before them contains pictorial, sculptural, or graphic design elements. If not, the inquiry ends, and the work is not protectable by U.S. copyright law. If so, the next question is whether those design elements can be separated from the utilitarian features of the work. With one exception, any of the available conceptual separability tests may be used to answer this question. In using any of the ten separability tests that apply, fact finders are able to err on the side of copyrightability. Copyright protection then would attach to the separable pictorial, graphic or sculptural design elements of the work that otherwise meet the statutory requirements for copyrightability.

ARGUMENT

I. BACKGROUND

The Sixth Circuit, in its opinion below, created a new and tenth conceptual separability test, adding to the already-long list of similar tests. Petitioner asks this court to select one of those ten separability tests as the prevailing rule to separate design and functional elements in useful articles from elements that may also be subject to copyright protection under the U.S. Copyright Act, 17 U.S.C. §101 *et seq.* (the "Act."). However, each of the various separability tests[1] can be helpful, depending on the facts of the particular case.

Because the different separability tests have their own usefulness, they should not be sidelined. They can be retained under a new approach that clarifies the Sixth Circuit's separability analysis in one important respect. The Copyright Act defines protectable pictorial, sculptural, and graphic works primarily by reference to their design elements; the "useful article" exception is a carve-out from that general definition. The court below improperly placed its primary focus on the useful features of the work, allowing utility to overshadow the importance of the creative design.

The Sixth Circuit's test, taken in the order described by the court, asks the following:

(1) Is the design a pictorial, graphic, or sculptural work?

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[1] On exception is discussed *infra* at 11-13.

(2) If the design is a pictorial, graphic, or sculptural work, then is it a design of a useful article?[5]

If the design is not that of a useful article, that is, if the potential creative work of authorship only contains design elements and no functionality, then the inquiry ends here and there is no need to apply a separability test. If it is a useful article, then once utilitarian aspects are identified, the analysis continues.

(3) What are the utilitarian aspects of the useful article?

(4) Can the viewer of the design identify pictorial, graphic, or sculptural features separately from the utilitarian aspects of the useful article?

If not, then the design is not copyrightable. If these features can be identified separately, then the analysis concludes by asking:

(5) Can the pictorial, graphic, or sculptural features of the design of the useful article exist independently of the utilitarian aspects of the useful article?

The Sixth Circuit answered questions one and two in the affirmative. *Id.* at 489-90. At step three, it defined three useful features of a cheerleading uniform—to cover the body of the wearer, wick away moisture, and withstand the rigors of the sport. *Id.*

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[5] "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101.

at 490-91.[6] Answering question four, the court concluded that the graphic designs were separately identifiable from the useful aspects of the uniform. *Id.* at 491. Finally, using multiple elements of existing separability tests, the court determined that the identified graphic designs could exist independently of the useful features of the cheerleading uniform. *Id.* at 491-93.

The analysis of the Sixth Circuit is unnecessarily complex. There is another option, one that relies on the analytical structure for determining the protectability of pictorial, sculptural and graphic design elements inherent in useful articles that is reflected in the Copyright Act.[7]

Defining the utility of a work at the outset limits the application of the separability tests. A work that is a useful article may have multiple and different utilitarian functions—functions that may change or evolve depending on the way the work is displayed

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[6] Here, the Sixth Circuit emphasizes that a utilitarian function of conveying information – such as the fact that the wearer is a member of a particular cheerleading team, or that a jockey wearing a particular silk rides a certain horse may not be considered as part of this analysis. *Id.* at 490-91. The statute makes clear that portraying the appearance of an article and conveying information are not utilitarian features and do not destroy the potential copyrightability of an otherwise protectable work. 17 U.S.C. § 101.

[7] Similarly, the Sixth Circuit concluded, like the Ninth Circuit, that decisions by the Copyright Office as to registrabilty should be given the deference described in *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944). *Varsity Brands*, at 479. The analytical structure used by the Copyright Office to decide separability issues is likewise entitled to a certain amount of deference.

or used. If the courts focus first on the pictorial, graphic and sculptural design elements actually before them, as the Copyright Act does, their analysis will be more sensitive to capturing those design elements, without being limited by a certain definition of utility. This will allow a more consistent and predictable analysis of whether the design elements truly are separable from those uses.

II. DESIGN RATHER THAN UTILITY SHOULD BE CONSIDERED FIRST

Placing the design elements front and center in the separability analysis is consistent with the statutory language and the constitutional foundation of the Copyright Act.

Under 17 U.S.C. § 102(a)(5), copyright protection subsists in, among other things, "pictorial, graphic, and sculptural works," which Section 101 defines as "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." The statute first focuses on design, and then articulates useful features of the work as an exception to the protection offered by the Copyright Act.

Indeed, it is only the creative features of a work which render the work original and therefore constitutionally entitled to copyright protection at all. *See Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 346 (1991) ("originality is a constitutionally mandated prerequisite for copyright protection"). Focusing on design features first therefore ensures that copyright law is in line with the design of the Act and its constitutional foundation.

Section 101 of the Act also provides that the design of a useful article may be considered "a pictorial, graphic, or sculptural work" only if it "incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." In addition, that provision defines the term "useful article" as, "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.' "

Consistent with this statutory structure and its constitutional foundation, the Court should articulate a threshold test (to be conducted before any consideration of conceptual separability) that first determines whether a work contains any original pictorial, graphic, or sculptural features—and if so, defines those elements. Only then should the court ask whether the pictorial, graphic, or sculptural features are separable from any utilitarian aspects of the work. Under this recommended analysis, any one of the multiple separability tests may be used to distinguish between the work's utilitarian features and its design.

In this complex area, examples can be particularly instructive. Consider a three dimensional, hollow item made of paper maché, designed to resemble an animal. Many people would consider this work to be a piñata that is useful in a party game. But if a user hangs it on the wall instead of filling it with candy for a party game, its utility has changed.

Under the Sixth Circuit's approach, a court would first ask whether this is a useful article, and, if so, would define the aspects of utility. However, such definitions do not allow for the consideration of various contexts in which the work might be used. The piñata may be used as home décor; cheerleading uniforms may be used as Halloween costumes. It may be impossible to determine all of the potential ways a particular article could be functional. Thus, any set of definitions would be too narrow.

However, defining aspects of utility in a work is not required to reach a conclusion regarding conceptual separability. Furthermore, it does not follow the plain language of the Copyright Act.

Considering the piñata example, the Copyright Office would look at the piñata first as a work that may be a work of creative authorship as a three-dimensional sculptural work.[8] Then, the Copyright Office would then consider whether the piñata also is useful. The very fact that the piñata can be used in multiple ways demonstrates that its sculptural design is not inseparably tied to a particular useful aspect. So in separating the two features, the Copyright Office would consider the sculptural design of a piñata side-by-side with a useful (but identical) piñata. Because the design of the piñata can be conceived and drawn or modeled as an artistic work separate from its design function, the Copyright Of-

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[8] *See* Compendium of U.S. Copyright Office Practices III, §903.1 (2014).

fice would conclude that the Act protects the design features inherent in the work.[9]

This type of analysis adheres both to the letter and spirit of the copyright law. And it demonstrates that potential pictorial, sculptural, or graphic design elements in a work are not necessarily tied to any one definition of utility.

You can have PGS part of an overall useful article that may be independent from the utilitarian aspects of the article. This approach takes into account the fact that useful articles often have many different functions. For example, the piñata could be used to hold and dispense candy as a party game, but it could also be used as a sculpture, hung on a wall, or as colorful decor. Fact finders' determinations of the creative aspects of a work should not be influenced by a particular definition of utility. Rather, courts and juries should acknowledge that utility is an exception to the protection afforded to pictorial, sculptural, and graphic designs under the Act.

Case law provides another example: the decorative belt buckle. In *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980), the belt buckles in question were described as "sculptural designs cast in precious metals—decorative in nature." *Id.* at 990. The court recognized that a work may have more than one useful function. The court was persuaded by the fact that consumers used the belt

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[9] Indeed, the Copyright Office registered the copyright in a sculptural work entitled, *Piñata*, Baloonata, Registration No. VAu000100904 (10/31/1986), www.uscopyright.org (last visited July 2, 2016).

buckles as jewelry too. *Id.* at 993. The court noted that the object, while decorative, could conceivably be used for many purposes other than to fasten a belt used to cinch a pair of pants at the waist; it could be used as a strap for a purse/satchel, as a paperweight, or as a cabinet pull. Under such circumstances, it is too limiting (and it is also irrelevant to the consideration of the copyrightablity of the pictorial, sculptural and graphic aspects of the work) to consider only a defined set of useful functions.

The *Kieselstein* court applied the "Primary-Subsidiary conceptual separability test," under which a pictorial, graphic, or sculptural feature is conceptually separable if it is "primary" to the "subsidiary utilitarian function." The court asked whether the utilitarian aspects of the belt buckles were primary, or merely subsidiary Id. Because consumers frequently used the belt buckles for purposes other than holding up their pants, the court found the buckles' usefulness was subsidiary to their primary function as a sculptural work. *Id.*

While the Primary-Subsidiary test is very similar to what is recommended here, there are differences. In the approach proffered here, the first consideration would be the question of design elements—the pictorial, graphic, or sculptural features of the work—with a subsequent determination of any useful features that may be exceptions and thus not protectable. Further, no weight is given to design over function. If no design elements are identified, the analysis would end.

III. Existing Conceptual Separability Tests are Too Limiting if Used Independently

Each of the existing conceptual separability tests is insufficient to be the only test a fact finder can use to decide whether and to what extent a pictorial, graphic, or sculptural work is useful and thus, potentially unprotected by the Act. Without the additional direction to first identify the design elements present in a work that may include pictorial, graphic or sculptural features, courts may focus on the useful nature of the work first and then, like the Sixth Circuit below, and the court in the *Kieselstein-Cord* opinion, conduct an overly-narrow utility analysis. Furthermore, without this additional direction, we can continue to expect inconsistent outcomes in these determinations across the circuits.[10]

Each separability test is improved, and its purpose clarified, when it is framed by the threshold question proposed here: are there any pictorial, graphic, or sculptural features of the work, and if so what are they?

Again, examples can be particularly helpful in cases like this one. Consider a wine glass with a three-dimensional sculpture wrapping around the stem. Under the analysis recommended here, the first question would be whether the work contains any design elements that might be protected by copyright law. The answer is yes—the wrap-around sculpture. The next question is whether functional elements exist that would not be protected under

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[10] *Varsity Brands*, at 494-97 (McKeague, J., Circuit Judge, dissenting).

copyright law based on the exception for useful articles. The answer here also is yes: the bowl, stem and foot of the wine glass are too plain to qualify as an original work of authorship. Note that it is not necessary to list the functional possibilities for the wine glass (*e.g.*, to drink wine, to drink other beverages, to serve pudding, to use as a small pedestal; even making such a list is too constricting).

Finally, one of the existing separability tests can be used to divide the design and functional elements in the work. For example, under the "Objectively-Necessary" approach,[11] the court would consider whether the artistic features of the design—the wrap-around sculpture—are necessary to the utilitarian function of the wine glass (to hold beverages, pudding, or operate as a small pedestal, for example). Under this conceptual separability test, the wrap-around sculpture is not necessary to the function of the work and thus, the sculpture would be protectable under the Copyright Act.

Note, too, that having multiple separability tests available gives the court the flexibility to err on the side of providing copyright protection for design elements. If the wine glass is analyzed under the Primary-Subsidiary approach, the usefulness of the wine glass, no matter how ornate the sculpture might be, might override the design elements because consumers typically use the glasses for drinking beverages.[12] Rather than being constrained by

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[11] *See Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419 (2nd Cir. 1985).

[12] *See Kieselstein-Cord, supra.*

this separability test, the court can turn to the Objectively-Necessary test.

There is one separability test, however, that should not be used: the "Likelihood of Marketability" approach. This test finds conceptual separability if there is a substantial likelihood that the work would still be marketable to some significant segment of the community simply because of its aesthetic qualities, even if it has no utilitarian use. This determination should not focus on the commercial potential or marketability of a pictorial, graphic, or sculptural work. *See, e.g., Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (citing and quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3]) (pictorial, graphic, or sculptural feature is conceptually separable if it would be marketable to a significant segment of the community based only on its aesthetic qualities, even if the work had no utilitarian use). In the *Galiano* case, the court considered whether casino uniforms were subject to copyright protection. *Id.* In its analysis, the court adopted the likelihood of marketability standard for garment designs only. *Id.* at 421. Under that test, the *Galiano* court declined to extend any protection to the casino uniforms at issue. *Id.* at 422. However, this analysis turns the issue of copyright protection on its head.

Requiring consideration of marketability challenges the strong public policy behind the Constitutional mandate, "[t]o promote the Progress of Science and useful Arts, by securing for limited [t]imes to [a]uthors and [i]nventors the exclusive [r]ight to their respective [w]ritings and [d]iscoveries." United States Constitution, Article I., Section 8, Clause 8.

Instead, it renders the Copyright Act a governor of popularity. The Copyright Act does not protect works of authorship only if they are popular or marketable. Rather, it protects all "creative works of authorship fixed in a tangible medium of expression." 17 U.S.C. § 102. To impose a requirement that the creative work be marketable in any fashion adds a factor to the threshold of creativity and is not grounded in the statue or the Constitution, and thus exceeds the authority granted to the judicial branch.

Finally, many courts, including the court below, have counseled against injecting judges' artistic preferences into copyright law. *Varsity Brands Brands, Inc., et. al v. Star Athletica*, LLC, 799 F.3d 468, 489 (6th Cir. 2015)("[W]e do [not] adopt the likelihood-of-marketability test because it privileges a judge's personal taste in popular art, if often based entirely on conjecture, and often is undermined by the simple fact that the defendant in a copyright action has copied the work at issue.") (Citations and internal footnotes omitted.)

IV. THE BALANCE BETWEEN CREATIVE ELEMENTS AND USEFUL ASPECTS IN WORKS WILL NOT BE DISTURBED BY THE ADOPTION OF THIS TWO-PART TEST

The application of the proffered two part test to the facts of the case at bar would not materially change the outcome of the Sixth Circuit's decision. In modifying the analysis as recommended, however, this Court will be creating an approach that adheres to one of the most fundamental tenets of the Copyright Act, and will create more predictable outcomes as well.

The proposed approach is not intended to create substantially different outcomes in copyright law in general. For example, it should not be used to create copyright protection in fashion designs (as opposed to fabric designs, which can be protectable under the Act) where none existed before.

Rather, this recommendation is designed to clarify a complex area of law by providing fact finders with both consistency in the case law and flexibility for the facts of individual cases. Because finders of fact would not be limited to one particular conceptual separability test, they would be free to apply the particular test that best fits the facts of the case they are considering. Different types of works that may have design components and utilitarian features would be appropriately analyzed under any one of the available conceptual separability tests.

CONCLUSION

Analysis of a potentially copyrightable work that combines decorative design and functionality should start by asking whether such design elements are present in the work. If so, then the analysis should ask whether the work also contains functional features. Importantly, it is not then necessary to define these functional features of the article in question, especially because the work may be useful in a potentially unlimited number of applications. None of those features would be copyrightable and thus, the inquiry is irrelevant. Only after that primary question is answered should the work be analyzed to determine whether its design and functionality can be separated. With narrow exceptions addressed

herein, any of the existing tests for conceptual separability may be used to define the protectable elements within the work.

Respectfully submitted,

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